

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Anthony G. Lutfallah )  
Application No. 10/752,406 ) Examiner: Carlos Lugo  
Confirmation No. 3878 ) Art Unit 3676  
Filed January 6, 2004 )  
For: Universal Stop for a Slidable Window )

**APPELLANT'S REPLY BRIEF**

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This constitutes Applicant's reply brief on appeal, in response to the Examiner's Answer mailed on July 25, 2007. This reply brief is timely filed. The information specified by 37 C.F.R. § 41.41 and M.P.E.P. 1208 is provided hereunder.

As an initial matter, the Examiner is thanked for the careful analysis that has been given in the Examiner's Answer. Nonetheless, the Examiner's Answer does not provide sufficient reason for maintaining the rejections of the claims of the present application. For the reasons that follow, the Examiner's rejections should be reversed.

**I.      STATUS OF CLAIMS**

Twenty-nine (29) claims were originally filed in the application, and six (6) were added in prosecution. Claims 24, 30-33, 35, and 36 are pending for appeal. All pending claims have been rejected. A detailed status of the claims is as follows:

- A.      Claims originally filed: 1-29
- B.      Claims canceled: 1-23, 25-29, and 34
- C.      Claims added: 30-36
- D.      Claims currently pending: 24, 30-33, 35, and 36
- E.      Claims allowed: None
- F.      Claims rejected: 24, 30-33, 35, and 36
- G.      Claims objected to: None
- H.      Claims on appeal: 24, 30-33, 35, and 36

The independent claims in this application are 24, 30, 35, and 36. Each of the claims involved in this Appeal (24, 30-33, 35, and 36) are included in the attached Appendix.

**II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following grounds of rejection are to be reviewed on appeal:

1. Whether claims 24, 30–33, 35, and 36 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,806,900 to Bratcher *et al.* (“Bratcher”) in view of U.S. Patent No. 6,575,681 to Kojima *et al.* (“Kojima”).
2. Whether claim 36 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,806,900 to Bratcher *et al.* (“Bratcher”) in view of U.S. Patent No. 6,250,694 to Weiland (“Weiland”).

### **III. ARGUMENTS**

#### **A. Rejection of Claims 24, 30-33, 35, and 36 as Obvious Over U.S. Patent No. 5,806,900 (“Bratcher”) in view of U.S. Patent No. 6,575,681 (“Kojima”)**

The Examiner has rejected claims 24, 30-33, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Bratcher in view of Kojima. As in the appeal brief, Applicants address claims 24, 30-33, and 36 together as a group and claim 35 separately.

##### **1. Claims 24, 30-33, and 36**

###### **a. Kojima is Non-Analogous Art and Not Properly Combinable With Bratcher**

Appellant restates that the Examiner has not established a *prima facie* case of obviousness with respect to claims 24, 30-33, and 36 on the basis that Kojima is non-analogous art, and thus, Bratcher and Kojima are not properly combinable to form an obviousness rejection. Appellant notes that the Examiner does not contest the Appellant’s assertion that Kojima is not in the applicant’s field of endeavor. Appellant also submits that Kojima is not reasonably pertinent to the particular problem with which the present invention is concerned.

The Examiner, in the Answer, asserts that Kojima teaches a device that can be attached to different cavities in members having different thicknesses. (Answer, P. 6, Lns. 10-15). However, the Examiner does not address the Appellant’s argument that the clip of Kojima is not designed, disclosed, or contemplated to operate with moving parts. Additionally, the Examiner has not addressed the Appellant’s argument that the arrangement of the flange (20) and locking parts (41) of Kojima, if incorporated into a window stop, would obstruct movement of the window. Appellant does not dispute that Kojima may have some similarity to the design of the claimed window stop. However, for the reasons stated above and in Appellant’s Brief, Kojima is not sufficiently pertinent to the particular problems faced by the Appellant that the Appellant would be expected to look to the teachings of Kojima when designing the window stop, especially considering that Kojima exists so far out of the Appellant’s field of endeavor. Thus, Bratcher and Kojima are not properly combinable to form an obviousness rejection, and the combination of Bratcher and Kojima to reject claims 24, 30-33, and 36 is not proper.

**b. Bratcher and Kojima Are Not Properly Combinable Because There Is No Motivation To Combine The Teachings Of The References**

Appellant restates that the Examiner has not established a *prima facie* case of obviousness with respect to claims 24, 30-33, and 36 on the basis that Bratcher and Kojima are not properly combinable to form an obviousness rejection, because there is no motivation to combine the teachings of the cited references.

The Appellant previously argued that the features of the resin clip of Kojima would require significant modification to be incorporated into a window stop. In response, the Examiner asserts that Bratcher discloses these features and relies on Kojima for generally disclosing the use of different engagement surfaces for use with members of different thicknesses, effectively ignoring the additional context and features of Kojima. (Answer, P. 8, Lns. 7-11). However, the Examiner later goes to considerable lengths to demonstrate the specific arrangement of the engagement surfaces (41) and the lip (20) of Kojima.<sup>1</sup> (Answer, P. 8, Lns. 14-17). The Examiner ignores the specific details and context of the clip of Kojima when such details and context tend to discourage combination of the references, but relies heavily on such details when necessary to reject the Appellant's claims. Appellant submits that this selective attention to the teachings of Kojima further highlights the fact that the Examiner has engaged in improper hindsight reconstruction. Thus, because the proposed combination of Bratcher and Kojima relies upon improper hindsight reconstruction, Appellant submits that no *prima facie* case of obviousness has been established with respect to claims 24, 30-33, and 36.

**2. Claim 35**

**a. Bratcher and Kojima Do Not Disclose A Planar Engagement Surface Extending From An Inner Edge To An Outer Edge**

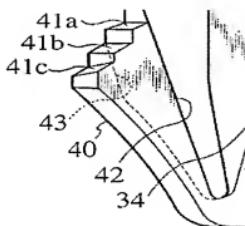
Appellant again submits that the Examiner has not established a *prima facie* case of obviousness with respect to claim 35, because the proposed combination of Bratcher and Kojima does not disclose, teach, or suggest at least the element, "a tab having a base portion mounted to the end wall and extending away from the end wall, the tab having a planar engagement surface

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<sup>1</sup> Appellant notes that, contrary to the statements in the Answer, Appellant did not argue that Kojima fails to disclose that the engagement surface is inclined with respect to the lip. Appellant merely pointed out that Kojima failed to disclose any advantage to such an arrangement that would cause one skilled in the art to incorporate the exact arrangement of these features into a window stop, as proposed by the Examiner.

distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip, the planar engagement surface extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing."

The Examiner's argument and Attachment #2 in the Answer ignore important terms in the above element of claim 35. Specifically, claim 35 recites that the planar engagement surface extends "from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing." In contrast, the "engagement surfaces" identified in Attachment #2 to the Answer only extend between the inner and outer edges of small ridges (41) at the end of the tab, as shown in the below figure from Kojima:



By definition, all finite surfaces extend from an inner edge to an outer edge. However, claim 35 specifically recites that the engagement surface extends from an inner edge to an outer edge of the tab. The individual surfaces (41) do not extend completely across the leg (40), and thus, do not meet the elements of the engagement surface as recited in claim 35. Applicant notes that these small ridges (41) do not have "a base portion mounted to the end wall and extending away from the end wall," so the ridges (41) cannot each individually be considered to be the recited tab. Thus, neither Bratcher nor Kojima discloses, teaches, or suggests this element of claim 35, and the Examiner's rejection of claim 35 over the combination of Bratcher and Kojima should be reversed.

**B. Rejection of Claim 36 as Obvious Over U.S. Patent No. 5,806,900 ("Bratcher") in view of U.S. Patent No. 6,250,694 to Weiland ("Weiland")**

The Examiner has rejected claim 36 under 35 U.S.C. § 103(a) as being unpatentable over Bratcher in view of Weiland. This was not addressed in Appellant's Brief because the rejection did not appear in the Final Office Action, but was reinstated by the Examiner after Appellant reinstated claim 36, which was done simultaneously with Appellant's filing of the initial Brief.

For the reasons stated below, Appellant submits that Bratcher and Weiland are not properly combinable to reject claim 36.

In rejecting claim 36 (previously original claim 24), the Examiner stated that the Bratcher reference fails to disclose that the surface of the resilient tab or extension member (34) is inclined with respect to the lip and that the engagement surface comprises at least one ridge or protrusion. The Examiner attempted to then apply Weiland as showing a resilient tab (44) that includes an engagement surface (46) to remedy the deficiencies of Bratcher. (Office Action of Mar. 23, 2005, Par. 11). However, no motivation or suggestion to combine the Bratcher and Weiland references has been cited by the Examiner.

Weiland is directed toward a push-push latch, such as for a door or drawer, that contains a shuttle (16) and a beam (14) disposed within a housing (12), and the shuttle and beam are moveable to lock the beam to a keeper (20). (Weiland, Col. 4, Lns. 13-17; Col. 5, Lns. 18-20). The housing (12) has a pair of snap legs (44), each having a ridged front end. (Weiland, Col. 4, Lns. 28-32). Appellant submits that, because the Examiner has not articulated any objective reason for one skilled in the art to combine the teachings of Bratcher and Weiland, the rejections can only result from hindsight reconstruction. Additionally, Weiland is directed to an internal latching mechanism, such as for a door or drawer, rather than an external window stop mechanism. As a result, one skilled in the art would not look to the teachings of Weiland to design or modify a window stop, and should not reasonably be expected to do so. Thus, because Bratcher and Weiland are not properly combinable, and because the proposed combination relies on improper hindsight analysis, no *prima facie* case of obviousness has been established with respect to claim 36.

**IV. CONCLUSION**

For the foregoing reasons, Appellant again respectfully requests that the Board reverse the Examiner's rejections, and order that claims 24, 30-33, 35, and 36 be passed to issue.

Respectfully submitted,

Date: September 25, 2007

By:

  
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